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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,612	04/14/2004	Hiroshi Kajiwara	00862.023540.	5087

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FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
NEW YORK, NY 10104-3800

EXAMINER

ROBERTS, JESSICA M

ART UNIT	PAPER NUMBER
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2621

MAIL DATE	DELIVERY MODE
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11/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/823,612

Applicant(s)

KAJIWARA, HIROSHI

Examiner

JESSICA ROBERTS

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/28/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7-10 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 2-6 and 12-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7-10 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

Claims 1, 7-10 and 24 are pending in this application. Claims **2-4, and 6** and **11** have been **canceled**. Claims **1, 9**, have been amended. Claim 24 has been added.

Response to Arguments

1. Applicant's arguments with respect to claims 1, 7-10, and 24 have been considered but are moot in view of the new ground(s) of rejection.
2. As to Applicants argument regarding that the claim recitation "sub-bitplanes" (referred to on page 4 of the Office Action) is supported by at least the third embodiment described in the specification.
3. The Examiner respectfully disagrees. Applicant does not have support for this claim limitation in the specification or the disclosure. The Examiner directs to Applicant to page of the original disclosure (summary) where sub-biplane is briefly referenced, however, this does not provide adequate support for sub-bitplanes.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim1, 7-10 and 24 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. Regarding claims 1 and 9, Applicant has claimed ..."a bitplane decoding step of reclaiming the plurality of coefficients of the plurality of subbands from encoded data of bitplanes or sub-bitplanes..."

7. Applicant does not have support for this claim limitation in the specification or the disclosure. The Examiner directs to Applicant to page of the original disclosure (summary) where sub-bitplane is briefly referenced, however, this does not provide adequate support for sub-bitplanes.

8. Further, regarding claim 1, Applicant has claimed..." the number $N(s, i)$ of lower-bit planes or lower-sub-bitplanes that are not to be decoded for each subband s and each index i , where $N(s, i)+1 \geq N(s, i) \dots$ ".

9. Applicant does not have support for the number $N(s, i)$ of lower-bit planes or lower-sub-bitplanes that are not to be decoded for each subband s and each index i , where $N(s, i)+1 \geq N(s, i) \dots$ ".

10. Re claim 7, which fails to remedy the issue stated above, thus claim 7 is rejected as being indefinite for depending upon claim 1.

11. Re, claim 8, which fails to remedy the issue stated above, thus claim 8 is rejected as being indefinite for depending upon claim 1.

12. Re, claim 10, which fails to remedy the issue stated above, thus claim 10 is rejected as being indefinite for depending upon claim 1.

13. Re claim 24, fails to remedy the issue stated above, thus claim 24 is rejected as being indefinite for depending upon claim 1.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1, 7-10 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Regarding claims 1 and 9, Applicant claims "the number $N(s, i)$ of lower-bit planes or lower-sub-bitplanes that are not to be decoded for each subband s and each index i , where $N(s, i)+1 \geq N(s, i)$. It is unclear to the Examiner what the index i represent. There is not enough information or description provided for the Examiner to form a reasonable interpretation of what Applicant intends the index i to represent.

17. Regarding claims 7-10 and 24 which fails to remedy the issue stated above, thus the claims 7-10 and 24 are too rejected as being indefinite for depending upon claim 1.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA ROBERTS whose telephone number is (571)270-1821. The examiner can normally be reached on 7:30-5:00 EST Monday-Friday, Alt Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/
Supervisory Patent Examiner, Art Unit 2621
/Jessica Roberts/
Examiner, Art Unit 2621